

Appl. No.: 10/740,035
Reply to Office Action of: 01/24/2007

REMARKS

Claims 15-17 and 19-26 were rejected under 35 U.S.C. §102(b) as being anticipated by Wood (US 2,304,984). Claims 15-17, 19-21, 24, 25, 28, 41 and 42 were rejected under 35 U.S.C. §102(b) as being anticipated by Davis et al. (US 5,897,823). Claims 15, 16, 19-21, 24, 27, 28 and 41 were rejected under 35 U.S.C. §102(b) as being anticipated by Byrne (US 4,162,138). The examiner is requested to reconsider these rejections.

In the office action the examiner stated that the language regarding the label and the clamping at its perimeter is intended use, and that the mold of Wood is clearly capable of clamping a label, and that the perimeter clamping is not a function of a structure of the mold, but rather the relative size of the label, and that perimeter clamping of the label had no patentable weight because application was not positively reciting the label as a structural element. Similar comments were made with regard to Davis et al. and Byrne.

Claim 15 has been amended above to positively recite a flexible label and also claim that the clamping members are clamp the flexible label at its perimeter within the mould void. In regard to the examiner's statements that Wood, Davis et al. and Byrne are "capable" of clamping a label, the examiner has clearly fallen victim to hindsight reasoning. Nowhere in Wood, Davis et al. and Byrne is that a disclosure or suggestion of a device having clamping members which clamp a flexible label at its perimeter within the mould void. Clamping a flexible member is different than clamping a rigid

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member for injection overmolding. Nowhere in the cited art is there a disclosure or suggestion of clamping a flexible label at its perimeter within a mould void.

As the examiner undoubtedly knows, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2).

In the present case, there is no disclosure or suggestion of modifying Wood, Davis et al. or Byrne into applicant's claimed invention. There is no disclosure or suggestion of the clamping members of Wood, Davis et al. and Byrne being capable of clamping a flexible label. Therefore, claim 15 is patentable and should be allowed.

Claim 17 has been amended to claim that the clamping members are adapted to clamp a flexible label within the mould void. In regard to the "adapted to" language, the examiner is directed to MPEP 2111.04 and In re Venezia 189 USPQ 149 (CCPA 1976) which explicitly held that the phrase "a pair of sleeves *** each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables" imparts a structural limitation to the sleeve. The court went on to hold that the

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language "adapted to be affixed" and "adapted to be positioned" also defines present structures or attributes of the part which limits the structure of the housing. Claim 15, as amended, is no longer in regard to "intended use", but instead has structural limitations regarding the clamping members being adapted to clamp a flexible label at its perimeter within the mould void. In the present case, there is no disclosure or suggestion of modifying Wood, Davis et al. or Byrne into applicant's claimed invention. There is no disclosure or suggestion of the clamping members of Wood, Davis et al. and Byrne being adapted to clamp a flexible label. Therefore, claim 15 is patentable and should be allowed.

Independent claims 22 and 41 have been amended similar to claim 17. It is believed that these independent claims are allowable for the same reasons as claim 17.

Though the dependent claims contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable independent claims. However, to expedite prosecution at this time, no further comment will be made.

New claims 53-56 have been added above to claim the features recited therein. Support for the claims may be found in Figs 2B and 2C and the bottom of page 8 for example.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is

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respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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